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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXPANSE NETWORKS, INC.
6206 KELLERS CHURCH ROAD
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EXAMINER

SHELEHEDA, JAMES R

ART UNIT	PAPER NUMBER
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2614

DATE MAILED: 02/26/2004

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/742,506

Applicant(s)

ELDERING ET AL.

Examiner

James Sheleheda

Art Unit

2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 December 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 7,9,11.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Drawings

1. The drawings are objected to because legends should be drawn to the blank boxes. See 37 CFR 1.84(o). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application.

The objection to the drawings will not be held in abeyance.

Claim Objections

2. Claims 13, 14, 20 and 22-24 are objected to because of the following informalities:

Claims 13 and 14, line 2, refer to "said subscriber node" when no such node is previously stated. "said subscriber node" should be changed to --said addressable unit--.

Claim 20, lines 2 refers to "said HTML files" when no such files are previously stated. "said HTML files" should be changed to --HTML files--.

Claims 22-24 are incorrectly dependent upon claim 21. Based upon applicant's previous claims, in claims 22-24, line 1, "claim 21" should be changed to --claim 20--.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 7, 8-11, 16, 17, 19, 26, 27-30 and 34 are rejected under 35

U.S.C. 102(b) as being anticipated by Alexander et al. (Alexander) (WO 99/04561).

As to claim 1, Alexander discloses a method for providing advertising in an electronic program guide for television (Fig. 1), said method comprising the steps of: **delivering** an electronic program guide to an addressable unit using a first communication channel (page 10, lines 21-34); **delivering** at least one advertisement to said addressable unit in a second communication channel (page 43, lines 27-36), said at least one advertisement being comprised of an Internet accessible file (downloaded ads from the Internet; page 43, lines 27-36); and **inserting** said advertisement into said electronic program guide (Fig. 1; page 34, lines 17-22).

As to claim 7, Alexander discloses wherein said advertisement delivery step comprises the steps of: **storing** said at least one advertisement on a network comprising said second channel at a node remote from said addressable unit (wherein the advertisement was stored at a remote Internet location; page 43, lines 27-36); and **retrieving**, at said addressable unit, said at least one advertisement from said remote node responsive to determination of an advertisement insertion opportunity (wherein advertising data is only accessed by the television system upon receipt of a website address; page 10, lines 16-26).

As to claim 8, Alexander discloses wherein said advertisement delivery step comprises the steps of **delivering** said at least one advertisement to said addressable unit at a time prior to determination of an opportunity to insert said advertisement into said electronic program guide (wherein advertisements are downloaded through the VBI and stored before selection; page 43, lines 27-36); and **storing** said advertisement in a memory local to said addressable unit for later retrieval (page 43, lines 27-36) responsive to determination of an advertisement insertion opportunity (wherein ads are inserted upon user selection of the EPG, page 42, lines 29-38 and page 43, lines 1-2).

As to claim 9, Alexander discloses wherein said insertion step further comprises retrieving said at least one advertisement from said local memory (page 43, lines 27-36).

As to claim 10, Alexander discloses wherein said advertisement inserting step comprises the steps of: **determining** if the electronic program guide is being viewed (by awaiting user interaction; page 34, lines 3-5); if said electronic program guide is being viewed, inserting said at least one advertisement into said electronic program guide (page 34, lines 3-5).

As to claim 11, Alexander discloses wherein said at least one advertisement comprises a plurality of advertisements, said method further comprising the steps of: **creating** a schedule for displaying said advertisements in said electronic program guide

(based upon scheduled times or priority levels; page 33, lines 36-38; page 34, lines 3-13 and lines 23-25); wherein said inserting step comprises inserting said advertisements in accordance with said schedule (page 44, lines 5-7).

As to claim 16, Alexander discloses wherein said electronic program guide includes a plurality of spaces dedicated to insertion of advertisements (Fig. 1, 14 and 16; page 26, lines 9-11) and wherein said inserting step comprises inserting an advertisement in each of said spaces (Fig. 1; page 44, lines 5-7).

As to claim 17, Alexander discloses wherein said schedule defines an expiration event for each advertisement (ad end times; page 33, lines 36-38 and page 34, lines 3-5) and wherein said method circuit further comprises the steps of: **detecting** said expiration event for any advertisement that has been displayed in said electronic program guide (wherein some means to detect the duration and end times must be present; page 33, lines 36-38 and page 34, lines 3-5); **removing** said displayed advertisement upon detection of said expiration event corresponding to said advertisement (some means must be present to stop the displaying of ads that have ended; page 33, lines 36-38 and page 34, lines 3-5); upon removal of any advertisement from said electronic program guide, **consulting** said schedule to determine a next advertisement to be inserted in said electronic program guide (corresponding to the ad with the next start time; page 33, lines 36-38 and page 34,

lines 3-5) and inserting said next advertisement in said electronic program guide in place of said removed advertisement (page 33, lines 36-38 and page 34, lines 3-5).

As to claim 19, Alexander discloses an apparatus (page 5, lines 35-38 and page 6, lines 1-15) for providing advertising in an electronic program guide for television (Fig. 1), said method comprising: a **receiver** (modem) for receiving an electronic program guide for television via a first communication channel (page 10, lines 21-34); a **receiver** for receiving advertisements via a second communication channel (page 43, lines 27-36), said at least one advertisement being comprised of an Internet accessible file (downloaded ads from the Internet; page 43, lines 27-36); and an advertisement **insertion circuit** for inserting said advertisement into said electronic program guide (wherein some circuit must be present in the television system to perform the advertisement insertion; Fig. 1; page 34, lines 17-22).

As to claim 26, Alexander discloses means for retrieving said advertisement from a remote location (wherein the advertisement was stored at a remote Internet location; page 43, lines 27-36) coupled to said apparatus via said second transport mechanism (through a modem; page 10, lines 16-24) responsive to determination of an advertisement insertion opportunity in said electronic program guide (wherein advertising data is only accessed by the television system upon receipt of a website address; page 10, lines 16-26).

As to claim 27, Alexander discloses means for retrieving said advertisements at a time prior to determination of an opportunity to insert said advertisement into said electronic program guide (wherein advertisements are downloaded through the VBI and stored before selection; page 43, lines 27-36); and a **memory** for storing said advertisement in a memory local to said addressable unit for later retrieval (page 43, lines 27-36) responsive to determination of an advertisement insertion opportunity (wherein ads are inserted upon user selection of the EPG, page 42, lines 29-38 and page 43, lines 1-2).

As to claim 28, Alexander discloses wherein said advertisement insertion circuit comprises means for retrieving said advertisements from said memory (page 43, lines 27-36).

As to claim 29, Alexander discloses a circuit for determining if said electronic program guide is being viewed (by awaiting user interaction; page 34, lines 3-5); wherein said advertisement insertions circuit inserts said advertisements into said electronic program guide only if said circuit for determining determines that said electronic program guide is being viewed (page 34, lines 3-5).

As to claim 30, Alexander discloses a circuit for creating a schedule for displaying said advertisements in said electronic program guide (page 33, lines 36-38; page 34, lines 6-13 and page 34, lines 23-25); and wherein said advertisement insertion

circuit inserts said advertisements into said electronic program guide in accordance with said schedule (page 44, lines 5-7).

As to claim 34, Alexander discloses wherein said schedule defines an expiration event for each advertisement (ad end times; page 33, lines 36-38 and page 34, lines 3-5) and wherein said advertisement insertion circuit further comprises: means for **detecting** said expiration event for any advertisement that has been displayed in said electronic program guide (wherein some means to detect the duration and end times must be present; page 33, lines 36-38 and page 34, lines 3-5); means for **removing** said displayed advertisement upon detection of said corresponding expiration event (some means must be present to stop the displaying of ads that have ended; page 33, lines 36-38 and page 34, lines 3-5); and means for **consulting** said schedule upon removal of any advertisement from said electronic program guide to determine a next advertisement to be inserted in said electronic program guide (corresponding to the ad with the next start time; page 33, lines 36-38 and page 34, lines 3-5) and inserting said next advertisement in said electronic program guide in place of said removed advertisement (page 33, lines 36-38 and page 34, lines 3-5).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Alexander as applied to claim 1 above, and further in view of Wang (6,667,385).

As to claim 18, while Alexander discloses wherein the electronic program guide is provided through Internet web pages (page 10, lines 26-34), he fails to specifically disclose wherein the electronic program guide comprises an HTML file.

Wang discloses digital television system which utilizes an EPG which comprises HTML (column 1, lines 6-10) for the advantage of allowing the EPG to easily incorporate various content formats and content (such as advertising; column 9, lines 54-64).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Alexander's system to include wherein the electronic program guide comprises an HTML file, as taught by Wang, for the advantage of allowing the EPG to easily incorporate various content formats and content (such as advertising).

7. Claims 12, 13, 14, 31 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alexander as applied to claim 11 above, and further in view of Yuen et al. (Yuen) (WO 98/27723).

As to claim 12, while Alexander discloses the scheduling of ads based upon priority (page 34, lines 23-25), he fails to specifically disclose wherein the schedule comprises a queue in a memory, said queue comprising an ordered list of

advertisement resource locators (ARLs), each of said ARLs comprising data disclosing a location of a corresponding advertisement.

Yuen discloses an EPG with inserted advertising wherein stored advertising is accessed according to a specified time in a list (page 3, lines 33-37), said list comprising an ordered list (by time) of addresses (or ARLs) disclosing the location in memory of the advertising inserts (page 3, lines 33-37), for the advantage of allowing tailored advertisements to be stored once in memory and accessed through scheduled links to the advertisement addresses (page 3, lines 33-37 and page 4, lines 1-2).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Alexander's system to include wherein the schedule comprises a queue in a memory, said queue comprising an ordered list of advertisement resource locators (ARLs), each of said ARLs comprising data disclosing a location of a corresponding advertisement, as taught by Yuen, for the advantage of allowing tailored advertisements to be stored once in memory and accessed through scheduled links to the advertisement addresses.

As to claim 13, Alexander and Yuen disclose wherein said is stored locally at said addressable node (Fig. 1, in memory 34 or 32; See Yuen at page 3, lines 33-37).

As to claim 14, Alexander and Yuen disclose delivering to said addressable node instructions dictating how to schedule said advertisements for display in said electronic program guide (advertiser specified criteria; See Alexander at page 33, lines 36-38 and

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page 43, lines 32-36); and wherein said step of creating said schedule comprises executing said instructions (See Alexander at page 44, lines 5-7).

As to claim 31, while Alexander discloses wherein said circuit schedules ads based upon priority (page 34, lines 23-25), he fails to specifically disclose wherein the schedule comprises a queue in a memory, said queue comprising an ordered list of advertisement resource locators (ARLs), each of said ARLs comprising data disclosing a location of a corresponding advertisement.

Yuen discloses an EPG with inserted advertising wherein stored advertising is accessed according to a specified time in a list (page 3, lines 33-37), said list comprising an ordered list (by time) of addresses (or ARLs) disclosing the location in memory of the advertising inserts (page 3, lines 33-37), for the advantage of allowing tailored advertisements to be stored once in memory and accessed through scheduled links to the advertisement addresses (page 3, lines 33-37 and page 4, lines 1-2).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Alexander's system to include wherein the schedule comprises a queue in a memory, said queue comprising an ordered list of advertisement resource locators (ARLs), each of said ARLs comprising data disclosing a location of a corresponding advertisement, as taught by Yuen, for the advantage of allowing tailored advertisements to be stored once in memory and accessed through scheduled links to the advertisement addresses.

As to claim 32, Alexander and Yuen disclose a receiver for receiving instructions dictating how to order said ARLs in said queue (wherein some receiver must be present to receive advertiser specified criteria; See Alexander at page 43, lines 32-36); and wherein said circuit for creating said schedule does so in accordance with said instructions (See Alexander at page 33, lines 36-38; page 43, lines 32-36 and page 44, lines 5-7).

8. Claims 15 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alexander and Yuen as applied to claim 14 above, and further in view of Arita (6,446,082).

As to claims 15 and 33, while Alexander and Yuen disclose wherein said ARLs comprise address locations of advertisements, they fail to disclose wherein said ARLs comprise URLs on the World Wide Web.

Arita discloses a program distribution system wherein the URLs of advertisements are stored in a file linking them to programming (column 7, lines 54-65) to allow the downloading of the advertisement from a server (column 7, lines 66-67 and column 8, lines 1-4) for the advantage of allowing advertising to be downloaded with programming as needed (column 2, lines 34-37).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Alexander and Yuen's system to include wherein said ARLs comprise URLs on the World Wide Web, as taught by Arita, for the advantage of allowing advertising to be downloaded with programming as needed.

9. Claims 3, 5, 22 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alexander as applied to claims 1 and 20 above, and further in view of Matthews, III et al. (Matthews) (6,631,523).

As to claim 3, while Alexander discloses wherein the EPG and advertisements are transmitted over some channels, he fails to specifically disclose wherein said first channel and said second channel comprise first and second transport streams, respectively.

Matthews discloses an EPG system wherein the EPG data and additional data associated with particular programs are transmitted to a receiver over two separate networks (transport streams; Fig. 3; column 7, lines 42-67 and column 8, lines 1-18) for the typical advantage of allowing access to alternative content available from a source other than the cable headend.

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Alexander's system to include wherein said first channel and said second channel comprise first and second transport streams, respectively, as taught by Matthews, for the typical advantage of allowing access to alternative content available from a source other than the cable headend.

As to claim 22, while Alexander discloses wherein the EPG and advertisements are transmitted over some channels, he fails to specifically disclose wherein said first and second channels comprise different transport mechanisms.

Matthews discloses and EPG system wherein the EPG data and additional data associated with particular programs are transmitted to a receiver over two separate networks (transport mechanisms; Fig. 3; column 7, lines 42-67 and column 8, lines 1-18) for the typical advantage of allowing access to alternative content available from a source other than the cable headend.

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Alexander's system to include wherein said first and second channels comprise different transport mechanisms, as taught by Matthews, for the typical advantage of allowing access to alternative content available from a source other than the cable headend.

As to claims 4 and 23, Alexander and Matthews disclose wherein said first transport stream (or mechanism) is digital broadcast satellite (see Matthews at column 7, lines 53-62).

As to claims 5 and 24, Alexander and Matthews disclose wherein said second transport stream (or mechanism) system comprises the Internet (see Matthews at column 7, lines 63-67).

10. Claims 6, 20 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alexander as applied to claims 1 and 19 above, and further in view of Crandall et al. (Crandall) (6,425,131).

As to claims 6 and 25, while Alexander discloses the receiving of an Internet file, he fails to specifically disclose wherein the Internet file comprises an HTML file including a Java file.

Crandall discloses a cable television system, wherein a HTML file including a JAVA applet is made available on server (column 4, lines 29-51) for downloading by a cable subscriber (column 5, lines 1-8) for the advantage of utilizing a file which can be designed to easily conform to a television screen (column 4, lines 36-42).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Alexander's system to include wherein the Internet file comprises an HTML file including a Java file, as taught by Crandall, for the advantage of utilizing a file which can be designed to easily conform to a television screen.

As to claim 20, while Alexander discloses a processing circuit (page 5, lines 35-38 and page 6, line 3) for processing Internet based files to generate displays corresponding thereto that can be inserted into said electronic program guide (wherein some processing must occur to incorporate the downloaded files into the EPG; page 43, lines 27-36), he fails to specifically disclose wherein the file is an HTML file.

Crandall discloses a cable television system, wherein a HTML file is made available on server (column 4, lines 29-51) for downloading by a cable subscriber (column 5, lines 1-8) for the advantage of utilizing a file which can be designed to easily conform to a television screen (column 4, lines 36-42).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Alexander's system to include wherein the Internet file comprises an HTML file, as taught by Crandall, for the advantage of utilizing a file which can be designed to easily conform to a television screen.

11. Claims 2 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alexander as applied to claims 1 and 20 above, and further in view of Mao et al. (Mao) (6,459,427).

As to claims 2 and 21, while Alexander discloses transmission over some channels, he fails to specifically disclose wherein said first and second channels are different channels of the same transport stream (or mechanism).

Mao discloses a digital broadcast TV network wherein program related advertising (column 3, lines 18-27) and EPG data (column 3, lines 7-16) are transported over different channels of the same transport stream (Fig. 1, wherein the set-top receives all data from the single HFC access network, 140; column 3, lines 7-16) for the advantage of enabling Internet data to be broadcast over an existing digital TV network (column 4, lines 59-65).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Alexander's system to include wherein said first and second channels are different channels of the same transport stream (or mechanism), as taught by Mao, for the advantage of enabling Internet data to be broadcast over an existing digital TV network.

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Conclusion

12. The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with all correspondence concerning this application or proceeding to establish a date of mailing or transmission under 37 CFR 1.8(a). Proper use of this procedure will result in such communication being considered as timely if the established date is within the required period for reply. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an individual who, upon information and belief, expects the correspondence to be mailed or transmitted in the normal course of business by another no later than the date indicated.

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

on _____.
(Date)

Typed or printed name of person signing this certificate:

Signature: _____

Certificate of Transmission

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, Fax No. (703) _____ - _____ on _____.
(Date)

Typed or printed name of person signing this certificate:

Signature: _____

Please refer to 37 CFR 1.6(d) and 1.8(a)(2) for filing limitations concerning facsimile transmissions and mailing, respectively.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Sheleheda whose telephone number is (703) 305-8722. The examiner can normally be reached on 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the primary examiner, Chris Grant can be reached on (703) 305-4755. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James Sheleheda
Patent Examiner
Art Unit 2614

JS


CHRIS GRANT
PRIMARY EXAMINER